

REMARKS:

Claims 29-52, and 54-56 are currently pending in the application.

Claims 1-28 and 53 have been previously canceled, without *prejudice*.

Claims 29-52 and 54-56 stand rejected under 35 U.S.C. § 103(a) over U.S. Publication No. 2008/0126265 to Livesay et al. ("*Livesay*") in view of U.S. Patent No. 6,874,141 to Swamy et al. ("*Swamy*").

Applicant notes with thanks the Examiner's response of 19 November 2009 and the Advisory Action of 1 February 2010.

Applicant respectfully submits that all of Applicant's arguments and amendments are without *prejudice* or *disclaimer*. In addition, Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. Applicant further respectfully submits that by not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are considered sufficient to overcome the Examiner's rejections. In addition, Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

I. Rejections Under 35 U.S.C. § 103(a)

Claims 29-52 and 54-56 stand rejected under 35 U.S.C. § 103(a) over *Livesay* in view of *Swamy*.

Applicant respectfully submits that while Applicant's claims in their prior, unamended form are not rendered obvious by the proposed combination of *Livesay* and *Swamy*, Applicant has currently amended Applicant's claims to expedite prosecution and issuance of the claims contained in the subject application. Applicant respectfully traverses the Examiner's obviousness rejection of

Claims 29-56 under 35 U.S.C. § 103(a) over the proposed combination of *Livesay* and *Swamy*, whether taken individually or in combination.

In rejecting Claim 29, the Examiner states that *Livesay* discloses:

receive information regarding a source schema and a target schema, the source and target schemas each comprising a taxonomy comprising a hierarchy of classes into which products are categorized, at least in Livesay discloses (FIG. 5 and paragraph [0019], . . . Referring to Applicant's specification on page 3 line 24-29, ordinary skill in the art would conclude that the grouping of good or services in categories provided in a profile which are stored in a database is the taxonomy comprising a hierarchy of classes into which products are categorized as claimed.

Indicate at least the source schema further comprising a product ontology associated with one or more of the classes, each product ontology comprising one or more product attributes

At least in FIG. 3C, 5 and paragraphs [0019] and [0109], wherein the grouping of goods and services after identifying dependencies/condition is the ontology comprising one or more product attributes.

(19 November 2009 Final Office Action, pages 6-7). Applicant respectfully disagrees with the Examiner's assertions.

The Examiner further states the following:

Livesay discloses: receive information regarding a source schema and a target schema, the source and target schemas each comprising a taxonomy comprising a hierarchy of classes into which products are categorized, at least in Livesay at least discloses (FIG. 5 and paragraph [0019] and [0128], wherein goods are categorized accounting to attributes)...

(1 February 2010 Advisory Action, page 2). Applicant respectfully disagrees with the Examiner's assertions.

For example, with regard to the Examiner's assertion that based on Applicant's specification, one of "ordinary skill in the art would conclude that the grouping of good or services in categories provided in a profile which are stored in a database is the taxonomy comprising a hierarchy of classes into which products are categorized as claimed," Applicant respectfully disagrees with the Examiner. Applicant respectfully reminds the Examiner that it is

improper that limitations from the specification may not be read into the claims during examination, as discussed in MPEP § 2100, which states the following:

"Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment." *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004).

Furthermore, it is not clear how the Examiner supports this assertion of the meaning of "taxonomy comprising a hierarchy of classes" based on page 3, lines 24-29 of Applicant's specification, provided below:

Therefore, certain embodiments of the present invention provide a translation tool that translates a source schema having one taxonomy to a target schema having a different taxonomy. Furthermore, one or more of the classes included in either of the taxonomies may have an associated ontology, which includes one or more attributes associated with a product or a seller of a product.

Applicant respectfully submits that the portion of Applicant's specification relied on by the Examiner fails to support the Examiner's assertion that one of ordinary skill in the art would understand a taxonomy comprising a hierarchy of classes into which products are categorized to be analogous to grouping of good or services in categories provided in a profile which are stored in a database. If the Examiner chooses to maintain this interpretation of Applicant's claim language, Applicant respectfully requests the Examiner to point to relevant prior art to establish the means of these terms as understood by one of ordinary skill in the art as Applicant's specification is not supportive of this interpretation.

Applicant respectfully directs the Examiner's attention to Figures 5 and paragraphs [0019], [0109] and [0128] of *Livesay*, provided below, on which the Examiner relies:

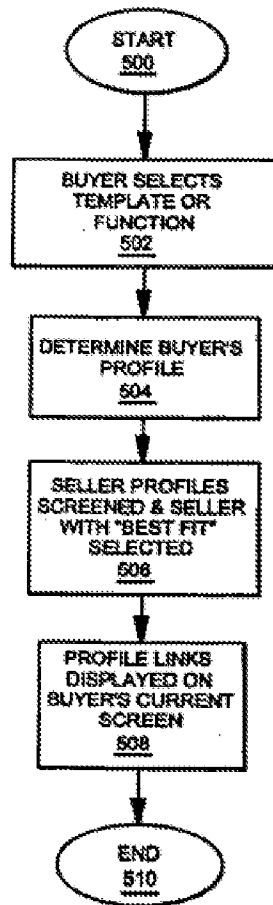


FIG.5

[0019] The present invention also preferably utilizes databases of sellers within which *profiles have been established to determine which sellers and which either goods or services, or goods and services are to be targeted to the various buyers at any time via a Profile Link*. For example, a database on seller XYZ may indicate that XYZ provides goods in categories 1, 2 and 3. *When buyer ABC accesses an on-line site or an application wherein goods in category number 2 are utilized, the present invention recognizes that XYZ provides such goods, and provides targeted marketing about XYZ's capabilities or products to ABC*, via a Profile Link, provided with the information page ABC is currently reviewing. The present invention may also recognize that ABC, for whatever reason, does not wish to engage in business with XYZ, or vice versa and thus, does not provide a Profile Link to XYZ's information. Thus, the present invention utilizes Profile Links to target the marketing of either goods or services, or goods and services to those most likely in need of such goods or services, or goods and services, especially while a buyer is actively pursuing the procurement of such goods or services, or goods and services.

[0109] *After identifying classifications of either goods or services, or goods and services and grouping such goods or services, or goods and services together, the process preferably determines whether a first grouping depends upon a second grouping for information* (Block 350). For example, the system might determine that a drill bit grouping depends upon casing information in order to know which type and/or diameter of drill bit to request. The process also examines whether descriptions of either goods or services, or goods and services exist for the groupings identified. For example, a drilling engineer might request specialized equipment for which either goods or services, or goods and services classifications do not exist. In such instances, the process preferably creates an error report that may be utilized to identify new groupings and sellers of either goods or services, or goods and services fulfilling each such grouping. Additionally, the process preferably converts groupings of either goods or services, or goods and services into specific goods or services, or goods and services descriptions that correlate to either goods or services, or goods and services descriptions being offered by a seller in a geographic area. In this manner, both the buyer and seller are in concurrence as to which goods or services, or goods and services are fulfilled by specific descriptions. (Emphasis added).

[0128] The present invention also provides a process that *allows sellers to pre-identify themselves as providers of goods or services, or goods and services based upon categories and/or classifications of goods or services*, or goods and services instead of identifying themselves based upon specific goods or services, or goods and services. Such identifications may include, for example, industry product codes. Similarly, the present invention may also be configured to facilitate the automated matching of buyers and sellers by searching the Internet and similar networks for sellers of goods or services, or goods and services when a general request is submitted by a buyer. Such features suitably expand the universe of potential sellers for a given request beyond those sellers pre-identified to the process—a feature that may be extremely valuable when rare goods or services, or goods and services are needed.

As shown above, based on the plain and ordinary meaning of the claim terms, Applicant respectfully submits that *Livesay* fails to disclose at least “*receiv[ing] source schema data and target schema data, the source schema data and the target schema data each comprising a taxonomy comprising a hierarchy of classes into which products are categorized,*” as required by Claim 29, as amended. By contrast, the above-referenced portion of *Livesay* discloses, among other things, providing targeted marketing to a buyer who accesses an online set that sells a particular category of goods using a Profile Link to convey this advertisement from the seller. There is no mention made of either source schema data or target schema data and certainly no mention made of a schema data that comprises a taxonomy comprising a hierarchy of classes

into which products are categorized. Merely categorizing products is insufficient to disclose a hierarchy of classes into which products are categorized. Applicant respectfully submits that a taxonomy comprising a hierarchy of classes according to its plain and ordinary meaning requires more than simply categorizing products, as asserted by the Examiner, but rather, requires the classes of products to be organized in a particular structure that forms a hierarchy. The portion of *Livesay* relied on by the Examiner is silent and therefore fails to disclose at least this limitation of Applicant's Claim 29, as amended.

Applicant further respectfully submits that the portion of *Livesay* relied on by the Examiner also fails to disclose at least ***“indicat[ing] at least the source schema data further comprising a product ontology associated with one or more of the classes, each product ontology comprising one or more product attributes,”*** as required by Claim 29, as amended. For at least the reasons discussed in detail above, the portion of *Livesay* relied on by the Examiner fails to disclose a hierarchy of classes and thus, cannot logically be said to disclose “a product ontology associated with one or more of the classes [of the hierarchy of classes],” as required by Claim 29. Applicant respectfully submits that merely grouping goods and services after identifying whether a first grouping depends on a second grouping for information as disclosed, among other things, in *Livesay*, does not equate to ***“indicat[ing] at least the source schema data further comprising a product ontology associated with one or more of the classes, each product ontology comprising one or more product attributes,”*** as required by Applicant's Claim 29, as amended.

While further distinctions exist, *Livesay*'s failure to disclose at least ***“receiv[ing] source schema data and target schema data, the source schema data and target schema data each comprising a taxonomy comprising a hierarchy of classes into which products are categorized,”*** and ***“indicat[ing] at least the source schema data further comprising a product ontology associated with one or more of the classes, each product ontology comprising one or more product attributes,”*** as discussed in detail above is more than sufficient to render amended Claim 29 patentably distinguishable from *Livesay*. Furthermore, *Swamy* also fails to disclose the missing teachings and as such, Applicant's claims are not rendered obvious by *Livesay* and *Swamy*, whether taken individually or in combination.

Accordingly, Applicant respectfully requests that the rejection of Claims 29-52, and 54-56 as obvious over the proposed combination of *Livesay* and *Swamy* be withdrawn and Claims 29-52, and 54-56 be allowed.

II. Office Action Fails to Properly Establish a *Prima Facie* case of Obviousness over the Proposed *Livesay-Swamy* Combination According to the UPSTO Examination Guidelines

Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Livesay* and *Swamy*, either individually or in combination, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*” (the “Guidelines”).

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, “While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.” (*KSR*, 550 U.S. at ___, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “***ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.***” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the

Guidelines remind Office personnel that the “*factual findings made by Office personnel are the necessary underpinnings to establish obviousness.*” (*id.*). Further, “*Office personnel must provide an explanation to support an obviousness rejection* under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject application, the Office Action has not shown the *factual findings necessary to establish obviousness* or even *an explanation to support the obviousness rejection* based on the proposed combination of *Livesay* and *Swamy*. The Office Action merely states that “it would have been obvious to a person in the ordinary skill in the art at the time of the invention to combine *Livesay* and *Swamy* by incorporating the teaching of *Swamy* into the system of *Livesay*.” (19 November 2009 Final Office Action, page 9). Applicant respectfully disagrees and respectfully submits that the Examiner’s conclusory statement is not sufficient to establish the *factual findings necessary to establish obviousness* and is not a sufficient *explanation to support the obviousness rejection* based on the proposed combination of *Livesay* and *Swamy*. *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including the factual findings necessary to establish obviousness to “ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.* (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (*See Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any “*obviousness rejection should include*, either explicitly or implicitly in view of the prior art applied, *an indication of the level of ordinary skill.*” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided *an indication of the level of ordinary skill*. *Applicant respectfully requests that the*

Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including an indication of the level of ordinary skill, relied upon by the Examiner. (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that ***Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.*** (*Id.*). In addition, the Guidelines state that the proper analysis is ***whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.*** (*Id.* and See 35 U.S.C. 103(a)).

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicant's invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to ***explain why the difference(s) between the proposed combination of Livesay, Swamy and Applicant's claimed invention would have been obvious to one of ordinary skill in the art.*** The Office Action merely states that one "having ordinary skill in the art would have found it motivated to use the mapping tool of Swamy into the system of Livesay for the purpose of providing a hierarchical data mapping." (19 November 2009 Final Office Action, page 9). Applicant respectfully disagrees and further respectfully requests clarification as to how this statement ***explains why the difference(s) between the proposed combination of Livesay, Swamy and Applicant's claimed invention would have been obvious to one of ordinary skill in the art.*** Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the "key to supporting any rejection under 35 U.S.C. 103 is the ***clear articulation of the reason(s) why the claimed invention would have been obvious.***" (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that ***"the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit."*** (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that "[R]ejections on ***obviousness cannot be sustained by mere conclusory statements***; instead, there

must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’’ (KSR, 550 U.S. at ___, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicant respectfully submits that the *Office Action fails to provide any articulation, let alone, clear articulation of the reasons why Applicant’s claimed invention would have been obvious*. For example, the *Examiner has not adequately supported the selection and combination of Livesay and Swamy to render obvious Applicant’s claimed invention*. The Examiner’s unsupported conclusory statements that “it would have been obvious to a person in the ordinary skill in the art at the time of the invention to combine Livesay and Swamy by incorporating the teaching of Swamy into the system of Livesay” and “one “having ordinary skill in the art would have found it motivated to use the mapping tool of Swamy into the system of Livesay for the purpose of providing a hieratical data mapping,” *does not adequately provide clear articulation of the reasons why Applicant’s claimed invention would have been obvious*. (19 November 2009 Final Office Action, page 9). In addition, the Examiner’s unsupported conclusory statement fails to meet any of the Guidelines rationales to render obvious Applicant’s claimed invention.

Thus, if the Examiner continues to maintain the obviousness rejection based on the proposed combination of *Livesay* and *Swamy*, *Applicant respectfully requests that the Examiner provide*

proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including a statement by the Examiner identifying which one of the seven rationales the Examiner is relying on and the proper analysis of that particular rationale, as required by the Guidelines.

III. Applicant's Claims are Patentable over the Proposed *Livesay-Swamy* Combination

Applicant respectfully submits that Claim 29 is considered patentably distinguishable over the proposed combination of *Livesay* and *Swamy*. This being the case, Claims 37, 45, and 54-56 are also considered patentably distinguishable over the proposed combination of *Livesay* and *Swamy*, for at least the reasons discussed above in connection with Claim 29.

Dependent Claims 30-36, 38-44, and 46-52 depend from Claims 29, 37, and 45, respectively. As mentioned above, each of Claims 29, 37, and 45 are considered patentably distinguishable over *Livesay*. Thus, dependent Claims 30-36, 38-44, and 46-52 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, Applicant respectfully submits that Claims 29-52 and 54-56 are not rendered obvious by the proposed combination of *Livesay* and *Swamy*. Applicant further respectfully submits that Claims 29-52 and 54-56 are in condition for allowance. Thus, Applicant respectfully requests that the rejection of Claims 29-52 and 54-56 under 35 U.S.C. § 102(e) be reconsidered and that Claims 29-52 and 54-56 be allowed.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

A Request for Continued Examination (RCE) is being filed electronically herewith to facilitate the processing of a credit card authorization. Although Applicant believes no additional fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

19 February 2010
Date

/Steven J. Laureanti/signed
Steven J. Laureanti, Registration No. 50,274

BOOTH UDALL, PLC
1155 W. Rio Salado Pkwy., Ste. 101
Tempe AZ, 85281
214.636.0799 (mobile)
480.830.2700 (office)
480.830.2717 (fax)
steven@boothudall.com

CUSTOMER NO. 53184